

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MASATAKA FUKUDA,
YASUNOBU MATSUMOTO, and
TOMOKO KONDO

Appeal No. 2002-1557
Application No. 09/305,746

ON BRIEF

Before SCHEINER, MILLS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

An oral hearing in this case was scheduled for January 23, 2003. Upon reviewing the case, however, we have determined that an oral hearing will not be necessary and we render the following decision based on the record. See 37 CFR § 1.194(c).

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2-14. Claim 6 is representative of the subject matter on appeal, and reads as follows:

6. A method for removing sebum selectively from the skin of a made-up face without removing make-up, which comprises applying a liquid composition to the skin by a technique other than spraying, followed by holding a water absorptive or oil absorptive material against the skin without wiping such that sebum and said liquid composition are selectively removed from the made up face.

The examiner relies upon the following reference:

Shimada et al. (Shimada)	5,462,691	Oct. 31, 1995
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Claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure. Claims 2-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and claim the subject matter that appellants regard as the invention. Finally, claims 2-14 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the teachings of Shimada. After careful review of the record and consideration of the issues before us, we find that on this record, we must reverse all of the rejections before us.

DISCUSSION

1. Rejection under 35 U.S.C. § 112, First Paragraph

The entire rejection, as it is set forth in the Examiner's Answer, is set forth below.

Claim 6 is rejected under 35 USC 112, first paragraph, because the specification, whole [sic] [while] being enabling for liquid compositions selected from those disclosed in Examples 2-7 (see page 11, Table 1), does not reasonably provide enablement for all possible liquids. The specification does not enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Examiner's Answer, page 4-5.

If, as the rejection states, the examiner is concerned with the scope of the liquid composition, it is unclear why only claim 6 stands rejected. Moreover, the statement of the rejection thus does not set forth any evidence or argument why the specification does not provide enablement for liquid compositions in the claims. Based on the response to argument, however, it is the panel's understanding that the examiner is concerned that Shimada discloses a liquid composition that also results in the removal of makeup. In addition, the examiner asserts that water is a liquid composition, and the specification at page 19, Table 2, indicates that when purified water is used alone, 50% of the sebum remained, and there was also some makeup spreading and retention. The examiner also notes that at page 18 of the specification, lines 2-6, "it is disclosed that in the case where the amount of liquid composition applied per unit area of skin less than 0.01 mg/cm² tend to cause make-up fading." Examiner's Answer, page 6.

Appellants argue in response that there is no basis for the examiner to doubt the objective truth of the disclosure, and thus the rejection should be reverse. Appeal Brief, page 11. We agree.

"[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented

must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.” In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971) (emphasis in original). “[It] is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” Id. at 224, 169 USPQ at 370. Here, the examiner has not provided “acceptable evidence or reasoning which is inconsistent” with the specification, and therefore has not met the initial burden of showing nonenablement.

The examiner contends that Shimada is evidence of non-enablement. A claim may, however, encompass inoperative embodiments and still meet the enablement requirement of 35 U.S.C. § 112, first paragraph. See Atlas Powder Co. v. E.I. Du Pont De Nemours & Co., 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984), In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 218 (CCPA 1976). The examiner has not provided evidence that it would require an undue amount of experimentation to determine those liquid compositions that would achieve the claimed method.

2. Rejection under 35 U.S.C. § 112, second paragraph

The entire statement of the rejection as found in the Examiner's Answer is set forth below.

Claims 2-14 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Examiners Answer, page 5.

The panel would first like to note that the statement of the rejection does not set forth what the examiner is objecting to. Again, looking to the examiner's response to argument, it appears that the examiner finds the phrases "by a technique other than spraying" and "an oily composition comprising an oily component" indefinite. See Examiner's Answer, page 7.

According to the examiner, the phrase "by a technique other than spraying" is ambiguous because "[i]t is unclear whether the claims are directed to every single technique known in the art, excluding spraying." Id. Similarly, the examiner finds the phrase "an oily composition comprising an oily component" vague and indefinite because "it is unclear what oily composition Appellant is referring to that is present in the composition," and that "[t]he composition may comprise any possible ingredients in addition to an oily component." Id.

The examiner's concern appears to be that the objected to terms are over-broad. "[B]readth is not to be equated with indefiniteness," and the rejection is reversed. In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); see also In re Hyatt, 708 F.2d 712, 714-15, 218 USPQ 195, 197 (Fed. Cir. 1983).

3. Rejection under 35 U.S.C. § 103(a)

According to the rejection, Shimada teaches a cleansing agent that is capable of both makeup removal and bare skin cleansing to clean dirt and sebum off of the skin. While the rejection notes that Shimada does not “specifically state” that a water or oil absorptive material is used to remove the sebum with the liquid composition, it concludes that:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to remove the sebum and/or makeup using an absorptive material because Shimada [] disclose[s] that their liquid composition may be rinsed off to remove dirt and makeup from the skin; however, a skilled practitioner would recognize that it is possible for some of the sebum and makeup to remain on the skin. Also, it should be noted from Examples 1-9 of Shimada [] that not all of the liquid compositions were removed from the subjects with rinsing; thus, it is obvious to use some other method to remove the remaining liquid.

Examiner’s Answer, page 4.

Appellants argue that Shimada fails to teach or suggest the selective removal of sebum, but, in fact teach only the complete removal of makeup, dirt and sebum. The claimed method, appellants argue, is drawn to the selective removal of sebum from the skin without removing makeup. We agree.

The burden is on the examiner to make a prima facie case of obviousness, and the examiner may meet this burden by demonstrating that the prior art would lead the ordinary artisan to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). Obviousness is determined in view of the sum of all of the relevant teachings in the art, not isolated teachings

in the art. See In re Kuderna, 426 F.2d 385, 389, 165 USPQ 575, 578 (CCPA 1970); see also In re Shuman, 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA 1966). In assessing the teachings of the prior art references, the examiner should also consider those disclosures that may teach away from the invention. See In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

Moreover, the findings of fact underlying the obviousness rejection, as well as the conclusions of law, must be made in accordance with the Administrative Procedure Act, 5 U.S.C. 706 (A), (E) (1994). See Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact underlying the obviousness rejection, upon review by the Court of Appeals for the Federal Circuit, must be supported by substantial evidence within the record. See In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). In addition, in order for meaningful appellate review to occur, the examiner must present a full and reasoned explanation of the rejection. See, e.g., In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002). The obviousness rejection of record does not meet the above criteria, and is thus reversed.

Claim 6 is drawn to “a method of removing sebum selectively from the skin of a made-up face without removing makeup.” Shimada, the reference relied upon by the rejection, is drawn to “a skin cleansing agent which is capable

of performing, in a one-stage process, both make-up removal and bare skin cleansing to clear off dirt and sebum from the skin.” Shimada, col. 1, lines 53-56 (emphasis added). There is no teachings, suggestions or motivations in Shimada for a method of removing sebum from the skin without the removal of makeup—Shimada in fact teaches away from the claimed invention by teaching that the object of the invention is to remove makeup, sebum and dirt from the face.

The examiner asserts that comparative examples 7 and 8 of Shimada did not result in the removal of makeup, and that while “Shimada [] do[es] not specifically state that their method selectively removes make-up, their examples indicate that depending upon the composition used make-up [sic?] [sebum] is selectively removed from the skin.” Examiner’s Answer, page 5 (emphasis in original). The examiner, however, is misinterpreting comparative examples 7 and 8. Shimada states that “both the make-up removal effect and bare skin cleansing effect were poor.” Shimada, col. 7, lines 40-41. Thus, neither makeup nor sebum was effectively removed from the skin, and the examples cited by the examiner do not support the examiner’s assertion that Shimada discloses selective removal of sebum from the skin.

CONCLUSION

On the record before us, because the examiner has filed to set forth a prima facie case of unpatentability, all of the rejections of record are reversed.

REVERSED

Toni R. Scheiner)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Demetra J. Mills)	
Administrative Patent Judge)	APPEALS AND
)	
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